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**OFFICE OF PETITIONS**

In re Application of

Sasaki

Application No. 10/042,713

Filed: 26 January, 2001

Attorney Docket No. SIP1P041

DECISION ON PETITION

This is a decision on the petition under:

- 37 C.F.R. §1.10,<sup>1</sup> supplemented via FAX on 30 May, 2002, pursuant to a 11 February, 2001,

<sup>1</sup> The regulations at 37 C.F.R. §1.10 provide:

**§1.10 Filing of papers and fees by "Express Mail."**

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

filing, requesting that the above-identified application be accorded a filing date of 26 January, 2002; and

- under 37 C.F.R. §1.183<sup>2</sup> and §1.102<sup>3</sup> for waiver of rules and advancement out of order (a petition to make special).

Therefore:

- the petition under 37 C.F.R. §1.10(e) is **GRANTED**;<sup>4</sup>

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

[48 Fed. Reg. 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 Fed. Reg. 4285, Jan. 31, 1983, paras. (a) & (c), 49 Fed. Reg. 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a) - (c) revised and paras. (d) - (f) added, 61 Fed. Reg. 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

<sup>2</sup> The regulations at 37 C.F.R. §1.183 provide:

**§ 1.183 Suspension of rules.**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982]

<sup>3</sup> The regulations at 37 C.F.R. §1.102 provide:

**§1.102 Advancement of examination.**

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in §1.17(h).

[24 Fed. Reg. 10332, Dec. 22, 1959; paras. (a), (c), and (d), 47 Fed. Reg. 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 54 Fed. Reg. 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (d) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (d) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

<sup>4</sup> Pursuant to Petitioner's authorization, the basic filing fee (\$740.00), surcharge (\$130.00) and the fee (\$130.00) for a petition under 37 C.F.R. §1.183 and §1.102 are charged to Deposit Account 550-0388(SIP1P041). The fee for the petition under 37 C.F.R. §1.10(e) is waived. Petitioner may wish now to record with the Assignment Branch any assignment(s) associated with this application.

- the petitions under 37 C.F.R. §1.183 and §1.102 are dismissed; while a delay has occurred in initial processing of the application, there is no indication at this time that there are extraordinary circumstances sufficient to satisfy the requirements of 37 C.F.R. §1.183, and Petitioner has otherwise failed to satisfy the requirements of 37 C.F.R. §1.102 and MPEP §708.02 (VIII).<sup>5</sup>

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<sup>5</sup> The commentary at MPEP §708.02 (VII) provides:

**VIII. SPECIAL EXAMINING PROCEDURE FOR CERTAIN NEW APPLICATIONS - ACCELERATED EXAMINATION**

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 C.F.R. 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;

- (C) Submits a statement(s) that a preexamination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

- (E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Technology Center (TC) Special Program Examiner.

Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

The special examining procedure of VIII (accelerated examination) involves the following procedures:

- (A) The new application, having been granted special status as a result of compliance with the requirements set out above will be taken up by the examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as examiner's answers, etc., and will be given a complete first action which will include *all* essential matters of merit as to all claims. The examiner's search will be restricted to the *subject matter encompassed by the claims*. A first action rejection will set a 3-month shortened period for reply.

- (B) During the 3-month period for reply, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. In order to afford the examiner time for reflective consideration before the interview, applicant or his or her representative should cause to be placed in the hands of the examiner at least one working day prior to the interview, a copy (clearly denoted as such) of the amendment that he or she proposes to file in response to the examiner's action. Such a paper will not become a part of the file, but will form a basis for discussion at the interview.

- (C) Subsequent to the interview, or responsive to the examiner's first action if no interview was had, applicant will file the "record" reply. The reply at this stage, to be proper, must be restricted to the rejections, objections, and requirements made. Any amendment which would require broadening the search field will be treated as an improper reply.

- (D) The examiner will, within 1 month from the date of receipt of applicant's formal reply, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a 3-month period for reply, or a notice of allowance. The examiner's reply to any amendment submitted after final rejection should be prompt and by way of form PTOL-303, by passing the application to issue, or by an examiner's answer should applicant choose to file an appeal brief at this time. The use of these forms is not intended to open the door to further prosecution. Of course, where relatively minor issues or deficiencies might be easily resolved, the examiner may use the telephone to inform the applicant of such.

- (E) A personal interview after a final Office action will not be permitted unless requested by the examiner. However, telephonic interviews will be permitted where appropriate for the purpose of correcting any minor outstanding matters.

After allowance, these applications are given top priority for printing. See MPEP §1309.

Petitioner alleges that the application was:

- deposited in US Postal Service (USPS) Express Mail service on Friday, 26 January, 2001;
- received at the Office on Monday, 29 January, 2001;
- mis-identified by the Office as Application No. 09/771,112; and
- thereafter misplaced by the Office.

In support of the allegation of:

- deposit: Petitioner submits a copy of the Express Mail Label EL631005145US (which number matches that on the application transmittal) evidencing a USPS “date in” and also hand-stamped as 26 January, 2001;
- receipt: Petitioner submits a copy of a FAX transmission on USPS letterhead documenting receipt by the Office of the above-referenced Express Mail packet from the USPS at 7:27 a.m. on Monday, 29 January, 2001;
- mis-identification by the Office as Application No. 09/771,112 with a 26 January, 2001, filing date: Petitioner submits a copy of the receipt card bearing the above-referenced Express Mail number and describing the instant application as consisting of:

1. Patent Application Transmittal
2. (48) Pages of Specification, Claims and Abstract
3. (12) Sheets of Formal Drawings

date-stamped by the Office and bearing Application No. 09/771,112;

- misplacement by the Office: Petitioner attests to having awaited receipt of a Notice of Missing Parts addressing the requirement for submission of a completed oath or declaration and filing fees that were not included in the 26 January, 2001, mailing. When no Notice was received, Petitioner’s office inquired and learned that the Application No. 09/771,112 was identified another application and not with the instant application.<sup>6</sup>

Petitioner submitted the instant petition and above-described documents, along with a copy of the entire original application, including: the Patent Application Transmittal, (48) Pages of Specification, Claims and Abstract, and (12) Sheets of Formal Drawings, as alleged to have been

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<sup>6</sup> A review of Office records confirms that the Application No. 09/771,112 is identified with a wholly-unrelated application.

originally filed.

Further, registered practitioner Steve D. Beyer (Registration No. 31,234) declares the accuracy of this information as submitted by him.

A review of the above-described receipt card reflects the Office receipt of documents, *inter alia*: 1. Patent Application Transmittal, 2. (48) Pages of Specification, Claims and Abstract, 3. (12) Sheets of Formal Drawings.

Because the return postcard receipt properly itemizes the contents of the application package in accordance with MPEP §503, the Office concludes that "Patent Application Transmittal, (48) Pages of Specification, Claims and Abstract, and (12) Sheets of Formal Drawings" were filed on 26 January, 2001, and that application was subsequently misplaced in the Office.


Accordingly:

- the petition under 37 C.F.R. §1.10(e) is **granted**;
- the petitions under 37 C.F.R. §1.183 and §1.102 are **dismissed** for cause and will not be reconsidered.

Petitioner is instructed that hereafter the correct application number to be used in referencing the instant application is Application No. 10/042,713 (and not 09/771,112).

This application is being forwarded to the Office of Initial Patent Examination for further processing in instant Application No. 10/042,713 and issuance of a filing receipt with a filing date of 26 January 2001, using Patent Application Transmittal, (48) Pages of Specification, Claims and Abstract, and (12) Sheets of Formal Drawings filed on 15 February, 2002, and resubmitted via FAX on 30 May, 2002, with an indication on the PALM bib data sheet that (48) Pages of Specification, Claims and Abstract, and (12) Sheets of Formal Drawings were present on filing. Thereafter, the application file will be forwarded to Technology Center 2600 for examination in due course.

Telephone inquiries specific to this decision should be directed to the undersigned at (703) 305-9199.

  
John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy